MISC. FEE TRANSMITTAL Patent fees are subject to annual revision. MAR 2 4 2006 MAR 2 4 2006

Attorney Docket Number

TOTAL AMOUNT OF PAYMEN

		METHOD OF PAYMENT	
⊠ Dep	osit Accou	unt	-
Dep	osit Accou	unt Number 13-2755 Deposit Account Name Merck & Co., Inc.	
The D	Director is	authorized to:	
	X Chai	rge fee(s) indicated below	
		Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	
		FEE CALCULATION	•
FEES Large E	ntity		
Fee	Fee	to to tate	
Code	(\$)	Fee Description	Fee Paid
1051	130	Surcharge - late filing fee or oath	
1051	130	Non-English Specification For filing a request for ex parte reexamination Filing a brief in support of an appeal	
1812	2,520	For filing a request for ex parte reexamination at the states of the sta	
1402	500	For filing a request for ex parte reexamination Filing a brief in support of an appeal Petition to revive - unavoidable Non-English Specification For a parter of the par	
1452	500	Petition to revive - unavoidable	
1453	1,500	Petition to revive - unintentional	<u> </u>
1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	Submission of Information Disclosure Statement August Submission of Information Disclosure Statement	
1809	790	Filing a submission after final rejection (37 CFR 直通语言 등	
1810	790	For each additional invention to be examined (37 CFR 1.129(b))	
1840	130	Statutory Terminal Disclaimer under 37 CFR 1.321	
		Other fee (specify) PETITION UNDER 37 CFR § 1.181(a)(1)	130
		Other fee (specify)	-
		TOTAL	\$130

	SUBMITTED BY	Com	olete (if applicable)		
Typed or Printed Name	CATHERINE D. FITCH			Reg. Number	36,502
Signature	Catherine Dor	Date	03/22/2006	Deposit Account User ID	

21071YP

Mend

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

MAR 2 4 2006

MERCK & CO., INC.

Date 3/22/06

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

W.K. Hagmann et al.

Serial No.:

10/509,277 Case No.: 21071YP

Art Unit:

1621

Filed:

September 27, 2004

Examiner:

For:

SUBSTITUTED ARYL AMIDES

S. Kumar

Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.181(a)(1)

Sir:

Under 37 C.F.R. § 1.181(a)(1), Applicants petition the action of the Examiner in the *ex parte* prosecution of the present application, making the rejection mailed February 16, 2006, final. Such a decision is not subject to appeal to the Board of Patent Appeals and Interferences or to the court. Applicants submit that the finality of the action was premature. Applicants respectfully request that the Director remove the finality of the rejection. The present Petition is being mailed within 2 months of the mailing date of the action from which relief is requested.

In the Office Action dated February 16, 2006, the Examiner rejected Claims 1-7 and 9-17 over a new piece of art, RN 95958-63-7, which the Examiner stated anticipated the present invention. The Examiner stated that Applicant's amendment express mailed December 14, 2005, and noted as filed December 16, 2006, necessitated the new grounds of rejection.

Applicants respectfully submit that the finality of the rejection was premature. The newly cited art was not "necessitated" by the amendments made in response to the first office action. The elements of the claims that allegedly fall within the newly cited prior art were present in the initial application.

In the December 14, 2005, response to the office action of September 15, 2005, (copy of both Office Action and Response enclosed), Applicants made the following amendments to the claims of the present application:

- Corrected spelling of "alkyl" in R¹ definition (Claims 1, 2)
- Corrected punctuation—replacing semicolon with a colon following "wherein" (Claim 9).
- Deleted phrase "each alkyl is optionally substituted with one, two, three or four substituents independently selected from Ra" from the definition of R². (R² did not have any alkyl groups). (Claims 1, 2)
- Amended R³ to be optionally substituted C₁₋₄ alkyl, by the deletion of "hydrogen" from the definition of R³ (Claims 1, 9, and 12),
- Deleted the provisos affecting compounds wherein R³ is hydrogen (Claims 1, and 9).

The amendment of R³ to be optionally substituted alkyl affected the scope of the claimed subject matter.

In the Office Action mailed February 16, 2006 (copy enclosed), the Examiner allowed Claim 8, and rejected Claims 1-7 and 9-17 under 35 USC § 102(b), over RN 95958-63-7 (copy enclosed), and objected to Claims 18-24 as being dependent on a rejected base claim.

RN95958-63-7 discloses the compound below:

RN 95958-63-7

The Examiner stated that RN 95958-63-7, anticipated the present invention when R¹ was phenyl substituted with chloro, R² was phenyl, R⁶ was H, R³ was methyl, and Ar¹ was phenyl substituted with carboxylic acid. The Examiner stated that since the compound can be in water (being carboxylic acid and amide derivative), and water being well known pharmaceutical carrier; the composition-was anticipated as well.

Applicants submit that the Examiner was premature in making the rejection over RN95958-63-7 final. The December 14, 2005, amendments substantively affected only the scope of R³. RN95958-63 applies to compounds wherein R³ is methyl. R³ as methyl was disclosed and claimed in the initial application, and was not affected by the December 14, 2005, amendments. The application of this art to the

claimed invention was not necessitated by the December amendments made in response to the first Office Action.

Applicants respectfully petition the Director to remove the finality of the February 16, 2006 office action under 37 C.F.R. § 1.181(a)(1), as being premature. (See, MPEP § 706.07(c))

The fee required by § 1.17(h) is enclosed. Any additional fees associated with this Petition or the prosecution of the above-identified application may be charged to Merck Deposit Account No. 13-2755.

Respectfully submitted,

By

Catherine D. Fitch, Reg. No. 36,502

Attorney for Applicants

MERCK & CO., Inc. P.O. Box 2000

Rahway, New Jersey 07065-0907

Tel: (732)594-4283

March 22, 2006

Encl.

Office Action of September 15, 2005 Amendment of December 14, 2005 Office Action of February 16, 2006 RN 95958-63-7 The CA roles and document type information have been removed from the IDE default display format and the ED field has been added, effective March 20, 2005. A new display format, IDERL, is now available and contains the CA role and document type information.

Structure search iteration limits have been increased. See HELP SLIMITS for details.

REGISTRY includes numerically searchable data for experimental and predicted properties as well as tags indicating availability of experimental property data in the original document. For information on property searching in REGISTRY, refer to:

http://www.cas.org/ONLINE/UG/regprops.html

=> s 95958-63-7 L3 1 95958-63-7 (95958-63-7/RN)

=> d

L3 ANSWER 1 OF 1 REGISTRY COPYRIGHT 2006 ACS on STN

RN 95958-63-7 REGISTRY

Entered STN: 21 Apr 1985

CN Phthalamic acid, N-[β-(p-chlorobenzyl)-α-methylphenethyl]-

(7CI) (CA INDEX NAME)

FS 3D CONCORD

MF C24 H22 C1 N O3

LC STN Files: CAOLD

PROPERTY DATA AVAILABLE IN THE 'PROP' FORMAT

1 REFERENCES IN FILE CAOLD (PRIOR TO 1967)

21071





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,277	09/27/2004	William K. Hagmann	21071YP	7661
210 75	90 09/15/2005		EXAM	INER
MERCK AND	CO., INC		KUMAR, SH	AILENDRA
POBOX 2000	07065-0907		ART UNIT	PAPER NUMBER

DOCKETED

SEP 1 9 2005

CHRISTINE A. CUFFE

1621
DATE MAILED: 09/15/2005

med med - 05

Please find below and/or attached an Office communication concerning this application or proceeding.

PATENT DEPARTMENT

SEP 2 0 2005

CATHERINE D. FITCH

Folder Pulled

	Application No.	Applicant(s)
	10/509,277	HAGMANN ET AL.
Office Action Summary	Examiner	Art Unit
•	SHAILENDRA - KUMAR	1621
The MAILING DATE of this communication a	1	
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REP WHICHEVER IS LONGER, FROM THE MAILING - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory perions are period for reply within the set or extended period for reply will, by state Any reply received by the Office later than three months after the main earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNICATION 1.136(a). In no event, however, may a reply be not will apply and will expire SIX (6) MONTHS for the cause the application to become ABANDO	ON. timely filed om the mailing date of this communication. NED (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed on 27	September 2004.	
	nis action is non-final.	
3) Since this application is in condition for allow		
closed in accordance with the practice under	r Ex parte Quayle, 1935 C.D. 11,	453 O.G. 213.
Disposition of Claims		
4) Claim(s) 1-24 is/are pending in the application	on.	
4a) Of the above claim(s) is/are withdo		
5)⊠ Claim(s) <u>8</u> is/are allowed.		
6)⊠ Claim(s) <u>1-7 and 9-24</u> is/are rejected.	·	2° g .4°
7) Claim(s) is/are objected to.		mag in the feeting of the
8) Claim(s) are subject to restriction and	I/or election requirement.	1 4 71 1
Application Papers		
9)☐ The specification is objected to by the Exami	ner.	The second secon
10) The drawing(s) filed on is/are: a) a		e Examiner.
Applicant may not request that any objection to the	ne drawing(s) be held in abeyance.	See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the corre	ection is required if the drawing(s) is	objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the	Examiner. Note the attached Offi	ce Action or form PTO-152.
Priority under 35 U.S.C. § 119		
12)☐ Acknowledgment is made of a claim for foreign	gn priority under 35 U.S.C. § 119	(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:		
1. Certified copies of the priority docume	ents have been received.	
2. Certified copies of the priority docume		
Copies of the certified copies of the pr		ived in this National Stage
application from the International Bure		
* See the attached detailed Office action for a li	st of the certified copies not recei	ived.
Attachment(s)		
1) Notice of References Cited (PTO-892)	4) Interview Summa Paper No(s)/Mail	
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/0 Paper No(s)/Mail Date 12/17/04. 		al Patent Application (PTO-152)

Art Unit: 1621

DETAILED ACTION

Claims 1-24 are pending in this application.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 12/17/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

- 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines R2 to be various groups but the alkyl, and at the same time depicts that each alkyl is substituted with various substituents, thus rendering claims indefinite.

Claim Rejections - 35 USC § 103

- 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1621

- 5. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - 1. Determining the scope and contents of the prior art.
 - 2. Ascertaining the differences between the prior art and the claims at issue.
 - 3. Resolving the level of ordinary skill in the pertinent art.
 - 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
- 7. Claims 1-7 and 9-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 899556.

GB"556 teaches structurally similar compounds, composition and method of use as claimed herein. See for example, page 1, column 1, lines 10-20. The difference between the reference and herein claimed compounds is that the reference has not made specific compounds as claimed herein.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to obtain compounds within the generic disclosure of the

Art Unit: 1621

reference, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving a successful pharmaceutical composition, for treating tumors, absent evidence to the contrary. Note that R1 and R2 in the reference can be halo and methyl or halo and methoxy, thus not covered by the proviso.

- 8. Claim 8 appears to be free of prior art and is allowable.
- 9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHAILENDRA - KUMAR Primary Examiner Art Unit 1621

S.Kumar 9/14/05

Su	ibstitute for form 1449A/PTO				COMPLETE IF KNOWN		
	NFORMATION	DIS	CLOSURE	Application Number	10/509,277		
	TATEMENT B	\$7 A Y1	DI ICANIT	Filing Date	September 27, 2004		
5	IAIEWENIB	ı Ar	PLICANI	First Named Inventor	W.K. Hagmann et al.		
				Group Art Unit	1621		
	(use as many shee	its as n	ecessary)	Examiner Name	5 Kumar		
Sheet	1	of	4	Attorney Docket Number	21071YP		

			U.S. PA	ATENT DOCUMENTS	
Examiner nitials*	Cite No.	U.S. Patent Document Number	Kind Code ((f known)	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
(V		5624941		Barth et al.	04/29/1997
		6028084		Barth et al.	02/22/2000
		5013837		Ward et al.	05/07/1991
		4973587		Ward et al.	11/27/1990
		5081122		Ward	01/14/1992
		5112820		Ward	05/12/1992
		5292736		Kumar et al.	03/08/1994
		6344474		Maruani et al.	02/05/2002
		USSN 60/515,705		Shah et al.	
		USSN 60/504,377		Armstrong et al.	
		USSN 10/507,864		Hagmann et al.	
		US2004-0058820		Hagmann et al.	03/25/2004
		USSN 60/483,679		Burns et al.	:. :
4		5658943		Berryman et al.	08/19/1997
alifathamen e	٠,	All the way with a second			
					1
		*		-	

		Foreign Patent Docum		DOCUMENTS	Date of Publication of
Examiner Initials*	Cite No.	Office Number	Kind Code (if known)	Name of Patentee or Applicant of Cited Document	Cited Document MM-DD-YYYY
ΔV		EP 658546		Sanofi-Synthelabo	05/23/2001
<u> </u>		WO 98/31227		SmithKline Beecham Corporation	07/23/1998
		WO 98/41519		SmithKline Beecham Corporation	09/24/1998
		WO 98/37061 .		Bayer Aktiengesellschaft	08/27/1998
1_7		WO 00/10967		Bayer Aktiengesellschaft	03/02/2000
\Box		WO 00/10968		Bayer Aktiengesellschaft	03/02/2000
		WO 97/29079		Japan Tobacco Inc.	08/14/1997
		WO 02/076945		Ortho-MacNeil Pharmaceutical, Inc.	10/03/2002
		WO 03/077847		Merck & Co., Inc.	09/25/2003
V		WO 03/086288		Merck & Co., Inc.	10/23/2003
Examine Signatur		S. Ku	mar	Date Considered	9/13/01

^{*}Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

SEND TO: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450. Computer generated form "IDS Form" (IDS Folder), Merck & Co., Inc., 09/05/2003)

Su	bstitute for form 1449A/PTO				COMPLETE IF KNOWN	
1	NFORMATION	DIS	CLOSURE	Application Number	10/509,277	
c	TATEMENT BY	7 A D	NY YO A NIT	Filing Date	September 27, 2004	
3	IAIEWENI DI	Ar.	PLICANI	First Named Inventor	W.K. Hagmann et al.	,
				Group Art Unit	. 1621	
	(use as many sheet	s as n	ecessary)	Examiner Name	S. Kumar	
Sheet	2	of	4	Attorney Docket Number	21071YP	

U.S. PATENT DOCUMENTS									
Examiner Initials*	Cite No.	U.S. Patent Document	Kind Code (if known)	Name of Patentee or Applicant	Date of Publication of Cited Document MM-DD-YYYY				
		<u> </u>							
			-						
			 						
			+						
			1						
			<u> </u>						
			<u> </u>						
··		معر ولايا - الحقول -							

		man auch unter in ter n in an auch e fin man passada di Fali bud ta-							
			1-1						

			FOREIG	PATEN'	T DOCUMENTS	······································
	C:4-		Foreign Patent Document			Date of Publication of Cited Document MM-DD-YYYY
Examiner Initials*	Cite No.	Office	Number	Kind Code (if known)	Name of Patentee or Applicant of Cited Document	
80		l	WO 03/082256		Sanofi-Synthelabo	10/09/2003
			WO 01/58450		Sanofi-Synthelabo	08/16/2001
			WO 01/85092		Sanofi-Synthelabo	11/15/2001
			EP 1328269		Aventis Pharma S.A.	05/26/2004
			WO 04/040040		UHDE GMBH	05/13/2004
			FR 1358M		L'Equilibre Biologique	06/18/2002
		,	WO 00/25774 .		Merck & Co., Inc.	05/01/2000
			GB 1172346		Parke, Davis & Company	11/26/1969
			GB 899556		Farbwerke Hoeschst Aktiengesellschaft	06/27/1962
de		1	WO 97/27852		Merck & Co., Inc.	08/07/1997

Examiner Signature S. Kulmar Date Considered 9 13 05

^{*}Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

	Substitute for form 1449A/PTO				COMPLETE IF KNOWN
	INFORMATION	DIS	CLOSURE	Application Number	10/507,864
	STATEMENT B	V A P	PLICANT	Filing Date	September 16, 2004
		· AI	LICANI	First Named Inventor	W.K. Hagmann et al.
	(use as many shee	ta on s		Group Art Unit	1621
	(ase as many snee	13 (13 /	ecessary)	Examiner Name	S. Kumar
Sheet	3	of	4	Attorney Docket Number	21071YP

		U.S. Patent Document	<u> </u>	ATENT DOCUMENTS	
Examiner Initials*	Cite No.	Number ·	Kind Code (if known)	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
		•			
	_				
	-	· .			
					
					·
-:		<u> </u>		1 1 2 2 2 2 2 2 2 2 2 2 2 2 2 2 2 2 2 2	
	_				
- 1	1				

		FORE	IGN PATEN	T DOCUMENTS	
Examiner Initials*	Cite No.	Foreign Patent Docume Office Number	Ent Kind Code (if known)	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
SU		WO 99/02499		Japan Tobacco Inc.	01/21/1999
-		WO 98/56754		L'Oreal	12/17/1998
4		WO 03/082190		Merck & Co., Inc.	10/09/2003
Examine					
Signature		S. Kuma	7	Date Considered	9/13/05

^{*}Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

SUBSTITUTE for PTOVS

Approved for use through 7/31/2006. OMB 0651-0031 (08-03), Information Disclosure Statement by Applicant Information Disclosure Statement by Applicant

(s	ubstitute for form 1449B/PTO				COMPLETE IF KNOWN	COMMERCE
1	NFORMATION	DIS	CLOSURE	Application Number	10/509,277	
S	TATEMENT BY	V AT	PPI ICANT	Filing Date	September 27, 2004	
		LAL	LICANI	First Named Inventor	W.K. Hagmann et al.	
	(use as many sheet	te ae s	1.000 Sec. m.)	Group Art Unit	1621	
	(use as many sneed	3 W3 H	ecessary)	Examiner Name	S. Krimar	
Sheet	4	of	4	Attorney Docket Number		

			NON PATENT LITERATURE DOCUMENTS
Exan Initia		Cite No.	Include name of the author, title, date, page(s), volume-issue number(s) and place of publication.
8	10	AA	Barth, Exp. Opin. Ther. Patents, Vol. 8 (1998), pp. 301-313, "Cannabinoid receptor agonists and antagonists"
		AB	Xiang et al., Ann. Rep. Med. Chem., A. Doherty, ed., Academic Press, NY (1999), Vol. 34, pp. 199-208, "Chap. 20. Pharrmacology of cannabinoid receptor agonists and antagonists"
		AC	Goya et al., Exp. Opin. Ther. Patents, Vol. 10 (2000), pp. 1529-1538, "Recent advances in cannabinoid receptor agonists and antagonists"
		AD	Piomelli et al., Trends in Pharm. Sci., Vol. 21 (2000), pp. 218-224, "The endocannabinoid system as a target for therapeutic drugs"
		AE	Lack et al., J. Pharmacol. Expt'l. Therap., Vol. 139 (1963), pp. 248-258, "The intestimal action of benzmalecene: The Relationship of its hypocholesterolemic effect to active transport of bile salts and other substances"
	×	AF	Julian et al., Eur. J. Org. Chem. (2000), pp. 1319-1325, "Asymmetric synthesis of 2,4-disubstituted tetrahydroioquinolines"
		AG	Lettre et al., Ann., Vol. 603 (1957), pp. 189-99, "Uber benzhydrylalkylamine. Ein beitrag zur analyse der mitosehemmenden wirkung des colchicins"

Examiner	Clause	Date	
Signature	J. K. C.Mar	Date Considered 9/12	101
Examiner: Initial if	ference considered subather and in it.	117	104

^{*}Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

SEND TO: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450. Computer generated form "IDS Form" (IDS Folder), Merck & Co., Inc., 09/05/2003)





210714P

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. BOX 1450
Alexandria, Virginia 22313-1450

APPLICATION NO.	FIL	ING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/509,277	509,277 09/27/2004		/509,277 09/27/2004		9,277 09/27/2004 -		- William K. Hagmann	21071YP	7661
210	7590	02/16/2006		EXAM	INER				
MERCK A		NC		KUMAR, SH	AILENDRA				
P O BOX 20 RAHWAY,		-0907		ART UNIT	PAPER NUMBER				
10111,	110 07005			1621	(6)				
			FEB 2 2 2006	DATE MAILED: 02/16/200	6				
			•		"Notice Tu				
					10 10				

Please find below and/or attached an Office communication concerning this application or proceeding.

PATENT DEPARTMENT

FEB 2 3 2006

CATHERINE D. FITCH

Refo Cital



RJH Feb 23 2006

•	Application No.	Applicant(s)
	10/509,277	HAGMANN ET AL.
Office Action Summary	Examiner	Art Unit
	SHAILENDRA KUMAR	1621
The MAILING DATE of this communication app		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim vill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed on 16 De	ecember 2005.	
2a)⊠ This action is FINAL . 2b)☐ This	action is non-final.	
3) Since this application is in condition for allowar	nce except for formal matters, pro	secution as to the merits is
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	53 O.G. 213.
Disposition of Claims		
_ 4)⊠ Claim(s) <u>1-24</u> is/are pending in the application.		
4a) Of the above claim(s) is/are withdraw	vn from consideration.	
5)⊠ Claim(s) <u>8</u> is/are allowed.		
6)⊠ Claim(s) <u>1-7 and 9-17</u> is/are rejected.		
7)⊠ Claim(s) <u>18-24</u> is/are objected to.		
8) Claim(s) are subject to restriction and/or	r election requirement.	· ·
Application Papers	* **	
9) The specification is objected to by the Examine		
10) The drawing(s) filed on is/are: a) acce	both or b) objected to by the	* * * * * * * * * * * * * * * * * * *
Applicant may not request that any objection to the		•
Replacement drawing sheet(s) including the correct		
11) The oath or declaration is objected to by the Ex	•	
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 119(a))-(d) or (f)
a) All b) Some * c) None of:	,	, (-, (,
1. Certified copies of the priority documents	s have been received.	
2. Certified copies of the priority documents		on No
3. Copies of the certified copies of the prior	rity documents have been receive	ed in this National Stage
application from the International Bureau	i (PCT Rule 17.2(a)).	
* See the attached detailed Office action for a list	of the certified copies not receive	ed.
Attachment(s)		
1) Notice of References Cited (PTO-892)	4) Interview Summary	
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ate Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	6) Other:	Company (100 100)

Art Unit: 1621

DETAILED ACTION

This office action is in response to applicants' communication filed on 12/16/05.

Claims 1-24 are pending in this application.

Rejection of claims 1-7 and 9-24 over GB 899556 is hereby withdrawn subsequent to applicants' amendment.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2. Claims 1-7 and 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by RN 95958-63-7.

RN 95958-63-7 anticipate instant claimed compounds when, in the instant claims, R1 is phenyl substituted with chloro, R2 is phenyl, R6 is H, , R3 is methyl, and Ar1 is phenyl substituted with carboxylic acid. Inasmuch compound can be in water(being carboxylic acid and amide derivative), and water being well known pharmaceutical carrier, the composition is anticipated too.

- 3. Claims 18-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 4. Claim 8 is allowed.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571)272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Page 4

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHAILENDRA - KUMAR Primary Examiner Art Unit 1621

S.Kumar 2/13/06

Notice of References Cited

Application/Control No.

10/509,277

Examiner

SHAILENDRA -. KUMAR

Applicant(s)/Patent Under
Reexamination
HAGMANN ET AL.

Art Unit
Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	Α	US-			
	В	US-			
	С	US-			
	D	US-			
	F	US-			
	F	US-			·
	G	US-			
	Н	US-			
	1	US-	16		
	J	US-	·		
	к	US-	0		
	L	US-			
	М	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					÷
	0					
	Р					
	Q				W.V	C
	R					
	S					
	Т					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
5	U	RN 95958-63-7, 1962.
	V	\$6.021222324253692128 \$6.0206 \$7.021222324253692128
	w	RECEIVED Case Reference Clerk Clerk
	х	110168732AEA

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).) Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.